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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,611	12/02/2003	Kenneth A. Martin	1190.08	4997

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EXAMINER	
COE, SUSAN D	

ART UNIT	PAPER NUMBER
1655	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/725,611	MARTIN ET AL.	
	Examiner	Art Unit	
	Susan D. Coe	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 July 2005 and 01 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *7,9,10,13-15,29 and 30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8,11,12,16-28,31 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-32 are currently pending.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-28, 31, and 32, 2-amino-2-deoxyglucose sulfate for species A, wheat and soy for species B, chocolate flavoring for species C, vitamins B, C, and E for species D, wheat for species E, saturated fat for species F, sugar and artificial sweetener for species G, fruit ingredient for species H, selenium and boron for species I, and bromelain and pepsin for species J in the replies filed on July 29, 2005 and November 1, 2005 is acknowledged. The traversal is on the ground(s) that election of species should not be required amongst the flavorings because "the group is directed to flavorings in order to enhance taste." Applicant also argues that a single species cannot be elected in the vitamins because the whole group of Group D is directed to vitamins. In addition, applicant argues that a single species cannot be elected from Group I since the group is directed to minerals. This is not found persuasive because election of species is allowed among any Markush group (see MPEP section 803.02). Members of a Markush group usually are a similar class of compounds such as vitamins or minerals. Thus, election between Markush groups that are all composed of vitamins or minerals or flavorings is not only allowed by the MPEP but is a routine practice.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 7, 9, 10, 13-15, 29, and 30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable

generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 29, 2005.

4. Claims 1-6, 8, 11-12, 16-28, 31, and 32 are examined on the merits solely in regards to the elected species.

Priority

5. This current application is a CIP of US Pat. No. 6,660,308. US '308 is directed to a beverage composition. US '308 does not teach a food bar composition and does not teach using protein or fiber in the composition. Thus, US '308 is not considered to support the currently claimed invention. Thus, for the evaluation of prior art, the date used is the filing date of the current application, December 2, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6, 8, 11-12, 16-17, 21-24, 26, 27, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US. Pat. Pub. No. 2003/0152642 and US Pat. No. 6,149,939.

US '642 teaches a food bar composition that is used to support joint health. The bar contains cartilage supplements such as glucosamine sulfate (2-amino-2-deoxyglucose sulfate) and chondrotin (see paragraph 24). The composition also contains vitamin C and calcium (see paragraphs 34 and 35). The bar is made out of vegetable oil (a fat), soy protein, whey protein, and wheat germ (see paragraph 42). The wheat germ is also a source of fiber. The composition is sweetened with sugar or an artificial sweetener or fruit or chocolate (see paragraphs 41, 43-45 and 23). The bar is produced by extrusion (see paragraph 52).

US '939 teaches a food bar for treating arthritis that comprises glucosamine, chondrotin, calcium, fish oil (which would contain vitamin A), vitamin B-5, vitamin C, vitamin E, and bromelain (see Example XI).

These references show that it was well known in the art at the time of the invention to use the claimed ingredients in food bar compositions that improve joint health. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that these substances are used in compositions to improve joint health, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating compositions to improve joint health. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See In re Sussman, 1943 C.D. 518; In re Huellmantel 139 USPQ 496; In re Crockett 126 USPQ 186.

The references do not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

7. Claims 18-20, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US. Pat. Pub. No. 2003/0152642 and US Pat. No. 6,149,939 as applied to claims 1-6, 8, 11-12, 16-17, 21-24, 26, 27, 31, and 32 above, and further in view of US Pat. No. 6,632,449.

The teachings of US '642 and US '939 are discussed above. The references do not specifically teach using boron, selenium, methylsulfonylmethane (MSM), or beta-carotene in the composition. US '449 teaches using boron, selenium, MSM, and beta-carotene in composition to treat arthritis (see abstract; column 10, lines 38-49; column 14, lines 14-15; and column 16, line 11). Based on the disclosure by these references that these substances are used in compositions to improve joint health, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating compositions to improve joint health. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See In re Sussman, 1943 C.D. 518; In re Huellmantel 139 USPQ 496; In re Crockett 126 USPQ 186.

The references do not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected

results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

8. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US. Pat. Pub. No. 2003/0152642 and US Pat. No. 6,149,939 as applied to claims 1-6, 8, 11-12, 16-17, 21-24, 26, 27, 31, and 32 above, and further in view of US Pat. No. 5,840,715.

The teachings of US '642 and US '939 are discussed above. The references do not specifically teach using pepsin in the composition. US '715 teaches using pepsin to digest cartilage to yield ingredients that are beneficial for joint health (see column 3, lines 50-56). Thus, a person of ordinary skill in the art would reasonably expect that adding pepsin to the cartilage containing supplement of US '642 would be beneficial because the pepsin would help digest the cartilage to product the active ingredients. This reasonable expectation of success would provide motivation to modify the composition taught by the combination of US '642 and US '939 to include pepsin.

The references do not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected

results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

9. Claims 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US. Pat. Pub. No. 2003/0152642 and US Pat. No. 6,149,939 as applied to claims 1-6, 8, 11-12, 16-17, 21-24, 26, 27, 31, and 32 above, and further in view of US Pat. No. 6,333,304.

The teachings of US '642 and US '939 are discussed above. The references do not specifically teach using selenium or grape seed extract in the composition. US '304 teaches using selenium and grape seed extract in composition to treat arthritis (see example V). Based on the disclosure by these references that these substances are used in compositions to improve joint health, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating compositions to improve joint health. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See In re Sussman, 1943 C.D. 518; In re Huellmantel 139 USPQ 496; In re Crockett 126 USPQ 186.

The references do not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that

would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over US. Pat. Pub. No. 2003/0152642 and US Pat. No. 6,149,939 as applied to claims 1-6, 8, 11-12, 16-17, 21-24, 26, 27, 31, and 32 above, and further in view of US Pat. No. 6,624,148.

The teachings of US '642 and US '939 are discussed above. The references do not specifically teach using quercetin in the composition. US '148 teaches using quercetin in composition to treat arthritis (see examples 2 and 3). Based on the disclosure by these references that these substances are used in compositions to improve joint health, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating compositions to improve joint health. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See In re Sussman, 1943 C.D. 518; In re Huellmantel 139 USPQ 496; In re Crockett 126 USPQ 186.

The references do not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the

optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-5, 8, 11, 12, 16-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/725,608. Although the conflicting claims are not identical, they are not

patentably distinct from each other because both sets of claims are drawn to ingestible supplements that contain glucosamine, protein, vitamins, fiber and numerous other ingredients in common. 10/725,608 does not specifically teach adding a flavoring; however, the composition does include ingredients that would have a flavor. In addition, it is well known to add flavorings to orally administered compositions. Thus, the claims of 10/725,608 are not considered patentably distinct from the current claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 9:30 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.

Susan D. Coe
12-15-05
Susan D. Coe
Primary Examiner
Art Unit 1655